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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

THANH, LOAN H

ART UNIT

PAPER NUMBER

3763

DATE MAILED: 05/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/635,083

Applicant(s)

LARSON ET AL.

Examiner

LoAn H. Thanh

Art Unit

3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 April 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 4-7, 11-14, 18 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 8-10 and 15-17 is/are rejected.
- 7) ☒ Claim(s) 20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 August 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2, 5, 7, 10.
- 4) ☒ Interview Summary (PTO-413) Paper No(s) 12.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of species II (figs. 10-12) in Paper No. 11 is acknowledged. The traversal is on the ground(s) that any additional burden associated with considering the various species does not appear to meet the necessary burden described in MPEP section 803(B)". This is not found persuasive because the Examiner imposed an election of species and not a restriction. See MPEP 808.01 (a). Burdensome is not the basis for arguments of an election of species since a separate status or separate classification in the art is not necessary. Applicant should be traversing on the ground that the species are not patentably distinct. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1, 4-7, 11-14, 18-19 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 11.

Further, it is agreed upon that claim 1 is generic to all embodiments.

An action on the merits now follows.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the fluid source and the hub disposed about the first elongate shaft proximate the proximal end thereof must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. If the housing (950) is suppose to be the hub then applicant is recommended to disclose that in the specification or at least make it clear in the record that is the case since the hub that is disclosed is the hub on the proximal end of the third elongated shaft.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because of the following:

- reference character "154" has been used to designate both a face and an inner surface. It is unclear whether applicant means "155" to be the "face" in the specification since the drawing fig. 1 shows "155".(see page 11, line 2.)

- reference character "790" has been used to designate both fluid and proximal portion.(see page 21, line 1 and fig. 9.)

- reference character "954" has been used to designate both a face and an inner surface. It is unclear whether applicant means "955" to be the face" since "954".(see page 21, line 17.)

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the

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description: 438 (see fig. 4), 230 ( fig. 10). (It seems as though 230 should be 930 which is disclosed in the specification on page 22, line 4).

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

The disclosure is objected to because of the following informalities: applicant has not disclosed the patent number or serial of the disclosed related applications in the first paragraph of the specification but has left it blank.

Appropriate correction is required.

The lengthy specification has been checked but not been checked to the extent necessary to determine the presence of all possible minor errors (i.e. grammatical errors). Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Laine et al, (U.S. Patent No. 5,261,889).

Laine et al. discloses a catheter shaft assembly having a first elongate shaft (10), a second elongate shaft (25) slidably disposed via at least one interstitial member (20) within the first elongate shaft (10). The at least one interstitial member (20) is disposed between the first (10) and second shaft(25). The interstitial member (20) is considered to be a projection beyond the outer surface of the second shaft (25). And during use (see fig. 4) the projection extends beyond the inner surface of the first shaft (10). See figs. 1-6 and col. 2-4.

Claims 1-3,8-10 are rejected under 35 U.S.C. 102(a) as being anticipated by Rosengart et al. ( WO 99/44656).

Rosengart et al. disclose a catheter shaft assembly (10) having a first (12,70) and second (60, 62) elongate shaft and at least one interstitial member (76) in between. Further, Rosengart et al disclose a hub disposed proximate the proximal end of the first elongated shaft (12) and a slider (24) disposed about the second elongate shaft (60) proximate the proximal portion. Further, the slider is disposed within a chamber defined by the hub wherein the slider extends the needle(60, 62) . With respect to the hub, it is considered to be the proximal portion which is wider at the proximal portion of the first elongated shaft (12). See figures 1,3-5, abstract and pages 6-8. With respect o claims 2-3,9-10, the interstitial member element (76) which projects from the outer surface of the second shaft and/or from the inner surface of the first

elongate shaft in as much as applicant has discussed that the interstitial member of applicant's can be the mechanical stop (974).

Claims 1-3,8-10, 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Lax et al (U.S. Patent No. 5,486,161).

Lax et al. disclose a catheter shaft having a first and second elongate shaft (42,32) and an interstitial member (36). The hub is disclosed as shown in fig. 1-3 as having a slider, a plurality of indicia (24,26). Lax et al. further disclose in col. 5, lines 6-8, that the second elongate member is for liquid delivery, thus it would be inherent that the device would have a fluid source.

With respect to claims 2-3,9-10,16-17, in as much as applicant has shown and discloses a projection extending beyond the inner or outer surface of the shafts, the reference also discloses the same and further in view of a broad interpretation of the language there is a radially and longitudinally projection beyond. ( The foundation of the reasoning is based on that applicant shows a shaft sliding within a lumen of another shaft and calls it a projection extending beyond either the inner surface or the outer surface. ). See figs. 1-9, cols. 4-5.

#### ***Allowable Subject Matter***

Claim 20 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LoAn H. Thanh whose telephone number is (703) 305-0038. The examiner can normally be reached on Monday - alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on (703) 308-3552. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.



LoAn H. Thanh  
Examiner  
Art Unit 3763

LT  
May 18, 2002